APPENDIX A

Statutes

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

35 U.S.C. 133. *Time for prosecuting application.* Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

§ 141. Appeals to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal

to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

§ 143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of

appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

APPENDIX B

I. Proposed Patent Office Rule

TITLE 37—PATENTS, TRADEMARKS AND COPYRIGHTS

Chapter I—Patent Office, Department of Commerce

PART 1—RULES OF PRACTICE IN PATENT CASES

Accessibility of Assignment Records

* * * *

The text of the proposed rule, as amended, reads as follows:

§ 1.12. *Assignment records open to public inspection.*—The assignment records, relating to original or reissue patents, including digests and indexes, are open to public inspection and copies of any instrument recorded may be

obtained upon payment of the fee therefor. Assignment records, digests and indexes, relating to any pending or abandoned application are not available to the public. Copies of any such assignment records and information with respect thereto shall be obtainable only upon written authority of the applicant or his assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules. An order for a copy of an assignment should give the identification of the record. If identified only by the name of the patentee and number of the patent, or in the case of a trademark registration by the name of the registrant and number of the registration, or by name of the applicant and serial number of the application, an extra charge will be made for the time consumed in making a search for such assignment.

(Sec. 1, 66 Stat. 793, 35 U.S.C. 6)

(Signed) EDWARD J. BRENNER,
Commissioner of Patents.

J. HERBERT HOLLOMON,
Assistant Secretary for Science and Technology.

Approved: May 26, 1965

Published in 30 F.R. 7195, May 28, 1965

II. Patent Office Rules

14. Patent applications preserved in secrecy. (a) Pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application

or papers relating thereto, without written authority of the applicant, or his assignee or attorney or agent, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

(b) Abandoned applications are likewise not open to public inspection, except that if an application referred to in a United States patent is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Abandoned applications may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

108. **Abandoned and forfeited applications not cited.** Abandoned and forfeited applications as such will not be cited as references.

TIME FOR RESPONSE BY APPLICANT; ABANDONMENT OF APPLICATION

135. **Abandonment for failure to respond within time limit.** (a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but considera-

tion of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See rule 7.)

137. **Revival of abandoned application.** An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee.

138. **Express abandonment.** An application may be expressly abandoned by filing in the Patent Office a written declaration of abandonment, signed by the applicant himself and the assignee of record, if any, and identifying the application.

APPENDIX C (1)

I. Decisions of Patent Office Board of Appeals

IN THE UNITED STATES PATENT OFFICE

Paper No. 14

Before the Board of Appeals

Appeal No. 20063

Ex parte Thomas H. Rogers, Jr.

Newell R. Bender and Theodore B. Burkholder

Application for Patent filed June 8, 1955, Serial No. 514,106. Pressure Mixing Process for Producing Cellular Products. R. L. Miller and F. W. Brunner and J. S. Holden for appellants.

Before Asp and Magil, Examiners-in-Chief, and J. S. Baily, Acting Examiner-in-Chief.
Magil, Examiner-in-Chief.

This is an appeal from the decision of the Primary Examiner finally rejecting claims 1 to 9, all of the claims in the application.

Claim 1 which is representative of the appealed claims is as follows:

1. In the process of preparing flexible elastomeric cellular structures from liquid reaction mixtures containing a polyisocyanate, water and an active-hydrogen-containing polymeric material selected from the group consisting of polyalkylene ether glycols, polyesteramides and polyesters, said polyesters being prepared from at least one glycol and at least one dibasic carboxylic acid, the improvement which comprises mixing the reaction mixture under a pressure ranging from 0.5 to 60 pounds per square inch above atmospheric pressure.

The reference relied upon is:

Hoppe et al. 2,764,565 Sept. 25, 1956

(Filed August 8, 1955; continuation-in-part of Serial No. 327,522, Filed December 23, 1952).

The Hoppe et al. patent carries forward the subject matter of the parent application Serial No. 327,522, but adds substantially thereto. Accordingly, only that disclosure which was originally presented in application Serial No. 327,522 is available as a reference against the claims of the instant application.

Appellants' process as well as that of the reference is sufficiently described in the appeal brief and in the Examiner's answer.

Appellants allege invention in only one aspect of the disclosed method for preparing cellular polyurethane products and that is the concept of mixing the reactants while under a pressure of from 0.5 to 60 pounds per square inch above atmospheric pressure.

The Examiner's position is that normal operation of the injection device shown in detail in Figure 2 of application Serial No. 327,522 would result in a build up of pressure in the mixing chamber 8 which must be greater than atmospheric for the mixture to flow from the outlet against the pressure of the atmosphere. To this extent, the Examiner's position is manifestly in accordance with known scientific principles. It is also considered obvious that the pressure within chamber 8 will be governed by factors including the rate of flow of materials through the chamber and the frictional resistance to fluid flow through the outlet as determined by, among other things, the diameter of the outlet and the viscosity of the mixture. While we must agree with appellants that the pressure behind the

nozzles feeding materials to the mixing chamber would have little direct relationship to the pressure within the chamber, we conclude that operation of the device in accordance with the disclosure of the reference would, under many conditions within the purview thereof, result in pressures in the mixing chamber within the scope of claims 1 to 9, and we are accordingly of the opinion that the claims define nothing patentable over the cited reference.

We agree with the Examiner that the affidavit of Bander is lacking as to factual data relating to the structure of the apparatus and procedural data as to the conditions of operation. However, it does indicate that very small variations in operating conditions well within the scope of the reference disclosure, such as the 1/32 "change in nozzle diameter between "Experiment I" and "Experiment II," may result in substantial variation in mixing chamber pressure in apparatus of this type.

The affidavit of Rogers is similarly lacking in factual data.

The Examiner presents a second ground for rejection of the claims as unpatentable over the cited reference, which is that page 5, lines 15 to 26, of the reference application discloses premixing of all of the components of the reaction mixture under pressure in a common mixing nozzle. The cited lines present several alternative procedures among which is included introduction of the activator through the common mixing nozzle which feeds both the polyester and the diisocyanate. We will also sustain this ground of rejection.

Appellants' arguments have been carefully considered, but, for the reasons indicated above, as well as for those set forth in the Examiner's answer, we conclude that the

appealed claims define nothing patentable over the cited reference.

The decision of the Examiner is affirmed.

Affirmed

Board of Appeals

N. A. Asp
Examiner-in-Chief

H. Magil
Examiner-in-Chief

J. S. Bailey
Examiner-in-Chief
(Acting)

J. B. Holden
The Goodyear Tire & Rubber Co.
Akron, Ohio

IN THE UNITED STATES PATENT OFFICE

Paper No. 16

Before the Board of Appeals

Appeal No. 200-63

Ex parte Thomas H. Rogers, Jr.

Newell R. Bender and Theodore B. Burkholder

Application for Patent filed June 8, 1955, Serial No. 514,106. Pressure Mixing Process for Producing Cellular Products. R. L. Miller and F. W. Brunner and J. B. Holden for appellants.

Before Asp and Magil, Examiners-in-Chief, and J. S. Bailey, Acting Examiner-in-Chief.

Magil, Examiner-in-Chief.

Request for Reconsideration

This is a request for reconsideration of our decision affirming the Examiner in his rejection of all of the claims

in this application. We have reconsidered the decision in the light of appellants' request and find no sufficient reason for coming to any different conclusion.

Relative to the Examiner's second ground of rejection, the mode of operation of the device of the Hoppe et al. reference is considered to be correctly interpreted in the Examiner's answer and in our decision of November 13, 1961. Inclusion of water along with the other ingredients in the common mixing nozzle described on page 5, lines 15 to 26, of the reference application for the stated purpose of foaming the plastic is regarded as within the purview of the disclosure.

Appellants submit four patents, all filed since the issuance of the Hoppe et al. patent, as evidence of their contention that no superatmospheric pressure would be built up in the mixing chamber of the reference Hoppe et al. application. The general rule of long standing that what has been allowed in other applications or patents will not be considered as evidence of patentability is considered properly applicable in this case. See *In re* Atwood, 46 CCPA 901; 747 O.G. 4; 267 Fed.(2d) 954; 122 USPQ 378; 1959 C.D. 321.

The petition has been considered but is denied with respect to making any change in our decision.

Board of Appeals

N. A. Asp
Examiner-in-Chief

H. Magil
Examiner-in-Chief

J. S. Bailey
Examiner-in-Chief
(Acting)

J. B. Holden
The Goodyear Tire & Rubber Co.
Akron, Ohio

APPENDIX C (2)

Decision of District Court

Filed December 20, 1963

OPINION

This is a civil action brought pursuant to 35 U.S.C. 145 in which plaintiffs seek judgment authorizing the defendant, Commissioner of Patents, to issue a patent containing claims 1 to 9, inclusive, of application Serial No. 514,106 filed by co-plaintiffs, Thomas H. Rogers, Newell R. Bender, and Theodore B. Burkholder on June 8, 1955. The co-plaintiff, Goodyear Tire and Rubber Co., is the assignee of the inventors.

No claims were allowed by the Patent Office. After the trial, counsel for plaintiffs withdrew claim 1 from the present action, and thus claims 2 to 9, inclusive, are before this Court. The parties agree that all these claims stand or fall together.

All the claims in suit are directed to an improved process of producing flexible, elastomeric cellular materials, i.e., polyurethane foams. The alleged invention resides in the concept of mixing the liquid reactant mixture of polymeric material, polyisocyanate and water under a pressure of from 0.5 to 60 pounds per square inch gauge.

The Board of Appeals affirmed the Examiner's rejection of the claims in suit as being unpatentable over the Hoppe et al. patent No. 2,764,565, which issued on application Serial No. 527,106, filed August 8, 1955. That application is a continuation-in-part of the now abandoned application Serial No. 327,522 filed December 23, 1952. The parties agree that only the disclosure brought forward from application Serial No. 327,522 is available as a reference since only that disclosure has a filing date earlier than the filing date of plaintiffs' application.

The Hoppe et al. application, Serial No. 327,522, discloses a process and apparatus for continuously preparing a stream of polyurethane plastic. The invention there resides in the intermittent injection of at least one of the reactants into a mixing chamber containing a continuously flowing stream of reactants. These injections are made through nozzles at high pressures—up to 1000 atmospheres —and frequencies. Additional stirring means are employed in the chamber so as to insure that the uniformly mixed stream of reactants is discharged therefrom in the liquid state and before any substantial liberation of gases has taken place.

That application also briefly discloses a modification of the above-described apparatus. "In this modification, the two components of the reaction mixture . . . are conveyed separately to a mixing chamber into which they are injected under pressure through separate nozzles, or a common mixing nozzle, and the activator is either conveyed separately to the mixing chamber and injected into it under pressure through a separate nozzle, or the common mixing nozzle, or is conveyed to the mixing chamber in admixture with one of the said components."

The tribunals of the Patent Office concluded that since in this modification *all* the liquid reactants are injected under pressure through the common mixing nozzle into a mixing chamber, it would have been obvious to one having ordinary skill in the art to mix all the liquid reactants under pressure in the manner recited by the claims in suit.

Undeniably, there are differences between the Hoppe et al. modification, and the claimed process. Hoppe et al. discloses that all the reactants are injected under pressure through a "common mixing nozzle" into a mixing chamber, or, in other words, the reactants are mixed under pressure as they pass through the nozzle, while the claims in suit recite that all the reactants are simply mixed under specified range of pressures in a chamber.

Therefore, the issue facing this Court is whether or not these differences are such that the claimed subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. In deciding this issue, the writer is mindful that the decision of the tribunals of the Patent Office is presumed to be correct, *Cook* v. *Watson,* 181 F. Supp. 896 (D.C.D.C. 1960), and that it should be followed unless the evidence introduced at trial demonstrates that there is clear error or lack of rational basis in that decision. *Abbott et al.* v. *Coe,* 109 F. 2d 449 (C.A.D.C. 1939), and *Schaefer* v. *Watson,* 288 F. 2d 144 (C.A.D.C. 1961).

It seems apparent to the writer that if Hoppe et al. can be said to suggest to one skilled in the art the concept of mixing liquid reactants under pressure in a chamber, the recitation of the range of pressures in the claims cannot be the basis for patentability. This is because that once that concept is realized, it would appear to require only ordinary engineering skill to find the specified range claimed.

In reaching a decision, the state of the art as of 1954-1955 must be examined since it is one of the best means by which a court can determine what would or would not have been obvious to a skilled person in the art. See *Upjohn Co.* v. *Italian Drugs Importing Co., Inc.,* 128 U.S.P.Q. 236 (D.C.S.N.Y. 1961).

From their introduction in the early 1950's, polyurethane foams had developed to the point that in early 1955, people working in the polymer field generally believed that polyurethane foam would be the next great synthetic. By this time, numerous companies, both foreign and domestic, were actively seeking processes which would permit large scale commercialization of this product. See the March 1955 issue of *Fortune* magazine.

Goodyear, one of the largest makers of conventional latex foam, was also one of the most active of these companies, and to further its development efforts, it had taken technical "know-how" licenses from several other competing companies, among whom was the Mobay Chemical Co., the United States licensor of the Hoppe et al. application. Several months after obtaining a license from Mobay, the application in suit was filed, and approximately one month thereafter Hoppe et al. filed their continuation-in-part application Serial No. 527,106.

Plaintiffs' evidence showed that none of the Mobay technical personnel had mentioned or suggested that maintaining a pressure in the mixing chamber would produce a greatly improved product. In fact, the first time that Mobay is purported to have told its licensees (including Goodyear) about this development was approximately a year after plaintiffs' application had been filed.

Since the record does not show that Goodyear told Mobay about the invention, and since there can be little doubt that the disclosure in the Hoppe et al. continuation-in-part application would be a complete anticipation of plaintiffs' invention if it had been filed early enough, it is apparent that at least two sets of inventors made the same invention at approximately the same time. This fact, coupled with the fact that the evidence did not show that plaintiffs' invention solved a long standing problem in the art, (this was understandable since the art was a relatively new, rapidly expanding one, and one in which a great many companies were actively engaged in development work) tends to negate plaintiffs' contention that their invention was an unobvious advance in the art. See *Audio Devices, Inc.* v. *Armour Research Foundation of Illinois Institute of Technology,* 130 U.S.P.Q. 323 (C.A. 2 1961); *Saul* v. *International Harvester Co.,* 120 U.S.P.Q. 177 (D.C. E. Wis. 1959), and *Clapper* v. *Original Tractor Cab Co., Inc.,* 116 U.S.P.Q. 316 (D.C. S. Ind. 1958).

Of course it should also be noted that during the trial, several expert witnesses testified that plaintiffs' invention would not have been obvious to them in view of the disclosure in the Hoppe et al. application. However, this opinion evidence must be balanced and tested against the above-mentioned facts. Admittedly, this case is extremely close, but for the reasons given above, the Court cannot say that the tribunals of the Patent Office were clearly erroneous in holding that the claims in suit were unpatentable over the Hoppe et al. patent.

Clearly, plaintiffs' invention resulted in an improved product. However, an improved product or result does not necessarily mean that the claims to the process of making that product or producing that result are patentable. See *In re Larson,* 130 U.S.P.Q. 209 (C.C.P.A. 1961); *In re Ross & Davis,* 134 U.S.P.Q. 320 (C.C.P.A. 1962), and *Benger Labs., Ltd.* v. *R. K. Laros Co.,* 135 U.S.P.Q. 11 (D.C. E. Pa. 1962).

In view of the above holding, the Court deems it unnecessary to discuss the other grounds of rejection made by the tribunals of the Patent Office and counsel for defendant.

In view of what has hereinbefore set out, the Court holds that the decision of the Board of Appeals has not been shown to be in clear error, and that judgment should issue for the defendant and against the plaintiffs.

The foregoing Opinion includes Findings of Fact and Conclusions of Law.

DATED: December 20, 1963.

JOSEPH R. JACKSON
Judge

APPENDIX C (3)

Decision of Court of Appeals

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,440

GOODYEAR TIRE AND RUBBER COMPANY, ET AL., APPELLANTS

v.

DAVID L. LADD, COMMISSIONER OF PATENTS, APPELLEE

Appeal from the United States District Court
for the District of Columbia

Decided June 24, 1965

Mr. Francis C. Browne for appellants.

Mr. Jack E. Armore, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore,* Solicitor, United States Patent Office, was on the brief, for appellee.

Before BAZELON, *Chief Judge,* EDGERTON, *Senior Circuit Judge,* and WASHINGTON, *Circuit Judge.*

PER CURIAM: The Patent Office rejected appellants' application, filed June 8, 1955, for a patent on the process of mixing the ingredients of polyurethane foams at pressures of 0.5 to 60 pounds per square inch above atmospheric pressure. The use of such pressures during mixing allegedly results in uniform and controlled cell size and eliminates fissures in the end product. Appellants then sued the Commissioner of Patents in the District Court under 35 U.S.C. § 145 for a declaration that they are entitled to the patent. The District Court entered judgment

for the defendant and dismissed the complaint, and the plaintiffs appeal.

Both the Patent Office and the District Court held the process unpatentable because the prior art made it obvious to a person with ordinary skill in the art, 35 U.S.C. § 103, relying on the Hoppe *et al.* patent No. 2,764,565, the application for which was filed two months after appellants' application. Hoppe's application was a continuation in part of an abandoned application filed two and a half years before appellants' application, and the parties agreed in the trial court that the continuation-in-part application is available as a reference to the extent its disclosures are also contained in the abandoned application. Though appellants now contest this, we have already held that, "as to all subject matter carried over into the continuing application from the parent application, the former is entitled to the filing date of the latter." *Asseff* v. *Marzall,* 88 U.S.App.D.C. 358, 359, 189 F. 2d 660, 661, *cert. denied,* 342 U.S. 828 (1951). The Hoppe *et al.* abandoned application discloses an apparatus for the production of polyurethane plastics, including foamed products. Under one modification of the apparatus the ingredients are conveyed simultaneously through a common mixing nozzle and injected under pressure "up to 1000 atmospheres" into a mixing chamber.[1] This modification was carried forward

[1] "In this modification the two components of the reaction mixture, namely at least one di-isocyanate and at least one hydroxyl-group-containing polyester, are conveyed separately to a mixing chamber into which they are *injected under pressure through* separate nozzles or a *common mixing nozzle,* and the activator is either conveyed separately to the mixing chamber and *injected into it under pressure through* a separate nozzle or the *common mixing nozzle* or is conveyed to the mixing chamber in admixture with one of the said components." Hoppe abandoned application, serial No. 327,522. "The reaction components and activator are preferably injected into the mixing chamber at a pressure up to 1000 atmospheres, the homogeneity and strength of the end product of porous or homogenous structure being thus improved." *Id.*

into the continuation-in-part application. See Hoppe *et al.* patent No. 2,764,565 (Sept. 25, 1956).

The Patent Office held that this disclosure would suggest the process of mixing the ingredients under pressure to one with ordinary skill in the art. Although some evidence at trial conflicted with this holding, the District Court agreed with the Patent Office, relying on its expertness and stating that obviousness was indicated by the facts that another inventor had discovered the process at about the same time as appellants did and that the problem was not of long standing in the art.[2]

The Patent Office's expertness in determining technical questions such as obviousness requires affirmance of its judgments unless they have no rational basis.[3] Since the Patent Office's finding of obviousness is supported by the record, the District Court's judgment is not clearly erroneous.[4] Therefore, the judgment must be

Affirmed.

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[2] See *L-O-F Glass Fibers Co.* v. *Watson,* 97 U.S.App.D.C. 69, 228 F. 2d 40 (1955), suggesting that the length of time a problem has existed is relevant to whether a solution to it is obvious.

[3] See *Schafer* v. *Watson,* 109 U.S.App.D.C. 360, 288 F. 2d 144 (1961); *Esso Standard Oil Co.* v. *Sun Oil Co.,* 97 U.S.App.D.C. 154, 229 F. 2d 37, *cert. denied,* 351 U.S. 973 (1956); *Abbott* v. *Coe,* 71 App.D.C. 195, 109 F. 2d 449 (1939).

[4] Rule 52(a), F.R.Civ.P., 28 U.S.C.A., governs our review of the District Court's opinion. *Schafer* v. *Watson,* note 3 *supra; Esso Standard Oil Co.* v. *Sun Oil Co.,* note 3 *supra; Standard Oil Development Co.* v. *Marzall,* 86 U.S.App.D.C. 210, 181 F. 2d 280 (1950).

APPENDIX D

Cases Dealing With Abandoned Applications as "Prior Art"

Rolls-Royce Ltd. v. *U. S.*, 339 F. 2d 654 (Ct. Cls. 1964)

Abandoned application referred to in an issued patent is evidence of "prior knowledge" of the claimed invention under 102(e) if early enough.

Technograph Printed Circuits, Ltd. v. *Bendix Aviation Corp.*, 218 F. Supp. 1 (W.D. Md. 1963) aff'd F. 2d 497 (C.A. 4 1964).

Abandoned application referred to in an issued patent is evidence of non-invention under § 103 where the issue date of the referenced issued patent was 4 years *prior* to the filing date of the patent in suit.

Ex parte Lipkin, 129 USPQ 427 (P.O. Bd. App. 1960).

Where Official Gazette abstract of abandoned application is used as a reference, entire application is evidence of public knowledge only as of date of publication of abstract.

Ex parte Gresham & McAlevy, 90 USPQ 350 (P.O. Bd. App. 1951).

Abandoned application referred to in issued patent is only useful as a reference *if* patentee relied upon the application for disclosure or if there is a special relation between them.

Ex parte Shacter & Griffith, 139 USPQ 380 (P.O. Bd. App. 1962).

If an abandoned application is referred to and relied upon by the patentee of an issued patent, it is a reference.

Ex parte MacDonald, 113 USPQ 262 (P.O. Bd. App. 1956).

Matter in abandoned application which is not carried over into continuing application *and* is not relied upon therein for completion of its disclosure is not available

as a reference against one who filed while first application was pending and secret.

B. F. Goodrich Co. v. *U. S. Rubber Co.*, 147 F. Supp. 40 (D.C. Md. 1956).

Abandoned application is evidence of "prior knowledge" of the claimed invention under 102(a).

Ex parte Tummers & Haayman, 137 USPQ 444 (P.O. Bd. App. 1962).

Continuation-in-part application disclosed only z. Parent application disclosed x + y + z.

Parent is good as a reference for z only. Since continuation-in-part application did not rely upon parent, the latter disclosure is not carried forward.

APPENDIX E

February 21, 1793, Chap. XI, Unitetd States Statutes at Large

SEC. 9. And be it further enacted, That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State, in writing and subscribed by them, or any two of them, shall be final, as far as respects the granting of the patent: And if either of the applicants shall refuse or fail to chuse (sic) an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

July 4, 1836, Chap. CCCLVII, United States Statutes at Large

SEC. 7 And be it further enacted, That, on the filing of any such application, description, and specification, and the

payment of the duty hereinafter provided, the commissioner shall make or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the commissioner that the applicant is not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back $20.00, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the commissioner, shall be sufficient warrant to the treasurer for paying back to the said applicant the said sum of $20.00. But if the applicant in such case shall persist in his claim for a patent, with or without any alteration of the specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claims shall not have been so modified as, in the opinion of the commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the

decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the commissioner, either in whole or in part, and their opinion being certified to the commissioner, he shall be governed thereby in the further proceedings to be had on such application: provided, however, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the Treasury, as provided in the ninth section of this act, the sum of $25.00 and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding $10.00, to be determined and paid by the commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

July 4, 1836, Chap CCCLVII, United States Statutes At Large

Sec. 16. And be it further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of Examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in an such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

(This review by bill in equity is considered in detail in a subsequent section of this paper.)

APPENDIX F

Cases Showing No Presumption of Correctness Given Patent Office Ruling By CCPA

In re Reid, 179 F. 2d 998 (CCPA 1950)

Express holding of Board is not controlling before CCPA on appeal.

In re Pappas et al., 185 F. 2d 695 (CCPA 1950)
In re Hummer, 241 F. 2d 742 (CCPA 1957)
In re Citron, 251 F. 2d 619 (CCPA 1958)

Any doubts as to patentability should be decided in favor of the applicant.

In re Knapp-Monarch, 296 F. 2d 230 (CCPA 1961)

Any finding of fact by the Board of Appeals may be challenged simply by contrary evidence on appeal.

In re Dwyer et al., 317 F. 2d 203 (CCPA 1963)

Patent Office interpretation of statement in reference is not binding.